



PATENT

Attorney Docket No. 4189.0083-03000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
 )  
KOHNO et al )  
 )  
Serial No.: 08/259,413 ) Group Art Unit: 1808  
 )  
Filed: June 14, 1994 ) Examiner: H. Lilling  
 )  
For: PEGYLATION REAGENTS AND )  
COMPOUNDS FORMED THEREWITH )

Assistant Commissioner for Patents  
Washington, D.C. 20231

**RESPONSE TO RESTRICTION REQUIREMENT**

In the Office Action mailed October 2, 1995, the  
Examiner required restriction to one of the following groups  
of claims:

Group I, claims 1-11 and 43;

Group II, claims 12-14;

Group III, claims 15-33 and 44;

Group IV, claims 34-37; and

Group V, claims 38-42.

Applicants elect with traverse Group III, claims 15-33  
and 44. Applicants traverse the restriction requirement.

First, since other claims of Groups I and III include within  
their formula a polymer having a reactive NHS-ester and a

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reactive Michael acceptor of claims of Group IV, a search for Groups I and III would necessarily encompass Group IV. Likewise, a search for the claims of Group III to the biologically active R<sub>1</sub> group attached to a polymer is intricately entwined with a search for the conjugate of the claims of Group I. Thus, the Examiner has not established the necessary prong to uphold a restriction requirement that a serious burden would exist if the claims were not restricted. The Examiner must show not only that the invention of different groups is patentably distinct, as set forth at page 4 of the Action, the Examiner must also establish that a serious burden would be required to search the two groups. See M.P.E.P. § 803 (e.g., at page 800-4, col. 1 of the M.P.E.P.).

The Examiner also requests that applicants elect a species for examination purposes. See Office Action at pages 4 to 9. Applicants understand that, if the Examiner finds the elected species patentable, examination will proceed with other species within the genus of the claim. If the Examiner is trying to restrict out species within a generic claim, however, applicants traverse this rejection as improper under controlling legal precedent.

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Although each of the following species may not be required for the elected group of claims, in an abundance of caution, applicants provide an election for each group set forth by the Examiner. The Examiner's numbering is used below.

For 17 (i), at page 4 of the Office Action, applicants elect (i) tumor necrosis factor (TNF) inhibitor.

For 17 (ii), at page 5 of the Office Action, applicants elect (b) maleimide.

For 17 (iii), at page 5 of the Office Action, applicants assume no election is required since maleimide was elected above. If an election is required, however, applicants elect vinyl sulfone.

For 17 (iv), at page 5 of the Office Action, applicants assume that no election is required since applicants elect PEG below. If an election is required, however, applicants elect polyalkylene oxide.

For 19 (A), applicants elect recombinantly made TNF.

For 19 (B), applicants elect PEG (ia) and a homopolymer (w).

Applicants also submit herewith a Petition to Revive an Unintentionally Abandoned Patent Application.

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If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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By: 

M. Paul Barker  
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Dated: October 23, 1996

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